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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

ARK, DARREN W

ART UNIT PAPER NUMBER

3643

DATE MAILED: 12/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/800,886

Applicant(s)

LORD, OCTAVE E.

Examiner

Darren W. Ark

Art Unit

3643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/21/2004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the “at least one downrigger counter...for supplying light to numbers on said downrigger counter” (the numbers on the counter which are being illuminated are not shown) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled “Replacement Sheet” in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In regard to claim 1, it is unclear from the specification and figures exactly how the downrigger counters are configured and how the numbers are arranged thereon which are to be illuminated by the lighting means. It is also unclear as to exactly how the counters operate to measure water depth and whether the counters represent ends of an elongated scale or whether the counters are the same devices providing the same depth readings.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 5-11, 14-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3643

In regard to claims 5-8, the term "a downrigger counter" renders the claim vague and indefinite since "at least one downrigger counter" was previously set forth and this term fails to refer back to "at least one downrigger counter".

In regard to claims 9-11, the terms "a first one of said downrigger counters" and "a second one of said downrigger counters" should be rewritten as "...of said at least one downrigger counter".

In regard to claims 14 and 15, the term "said fiberoptic connection" lacks positive antecedent basis.

In regard to claims 14 and 15, the term "an associated downrigger counter" renders the claim vague and indefinite since "at least one downrigger counter" was set forth previously.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by King 4,050,180.

King discloses a downrigger board assembly (12, 13 or 80); at least one downrigger counter (36); lighting means (see circuit diagram of Fig. 8 with light bulb shown; light can travel from the area of 60 toward 36, no specific intensity is recited).

Art Unit: 3643

8. Claims 1, 2, 5, 6 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Landell et al. 4,691,470.

Landell et al. discloses a downrigger board assembly (20; assembly is not being particularly recited); at least one downrigger counter (ruler on 20 in Figs. 1, 2, 4); lighting means (38).

In regard to claims 5 and 6, Landell et al. discloses a counter at each end (ruler has portions at each end of 20).

9. Claims 1, 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Adams et al. 4,422,258.

Adams et al. discloses a downrigger board assembly (10; assembly is not being particularly recited); at least one downrigger counter (35; counter not being particularly claimed); lighting means (42-44).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over King 4,050,180.

Alternatively, King discloses a single counter on one end of the board assembly, but does not disclose a downrigger counter on a downrigger counter at each end of the

Art Unit: 3643

downrigger board assembly. It would have been obvious to one having ordinary skill in the art at the time the invention was made to employ a downrigger counter at each end of the downrigger board assembly, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art, and because a counter on each end of the downrigger board assembly would allow the user to easily view the depth counter from multiple positions so as to be able to view depth indication at the closest one. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

12. Claims 5, 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over King 4,050,180 in view of Booth et al. 4,000,653.


Alternatively, King discloses a single counter on one end of the board assembly, but does not disclose a downrigger counter on a downrigger counter at each end of the downrigger board assembly. Booth discloses in Fig. 7 a system for providing an indication of the length of control line payed out at a remote location where it is desired to be viewed by the user. It would have been obvious to a person of ordinary skill in the art to modify the downrigger board assembly of King such that it has a counter at each end thereof in view of Booth et al. in order to provide the user with the necessary access to the information displayed by the counter at the desired location close to the user.

Art Unit: 3643

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darren W. Ark whose telephone number is (703) 305-3733. The examiner can normally be reached on M-Th, 8:00am-6:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter M. Poon can be reached on (703) 308-2574. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Darren W. Ark
Primary Examiner
Art Unit 3643

DWA